



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,621	10/06/2006	Maria Elena Ferrero	2503-1228	3886
466	7590	12/18/2007	EXAMINER	
YOUNG & THOMPSON			CRANE, LAWRENCE E	
745 SOUTH 23RD STREET			ART UNIT	PAPER NUMBER
2ND FLOOR			1623	
ARLINGTON, VA 22202				
MAIL DATE		DELIVERY MODE		
12/18/2007		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/589,621	FERRERO, MARIA ELENA
Examiner	Art Unit	
L. E. Crane	1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on October 2, 2007 (amendment).

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-15 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 1-15 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 16 August 2006 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) Notice of Informal Patent Application
6) Other: _____.

No claims have been cancelled, claims 1-6 have been amended, the disclosure and the abstract have been amended, and new claims 7-15 have been added as per the amendment filed October 2, 2007. No additional or supplemental Information Disclosure Statements (IDSs) have been filed as of the date of the Office action.

Claims 1-15 remain in the case.

Note to applicant: when a rejection refers to a claim X at line y, the line number "y" is determined from the claim as previously submitted by applicant in the most recent response including ~~lines deleted by line through~~.

Claims 1-15 are rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The instant disclosure has only provided two examples wherein the effectiveness of "po-ATP" in the inhibition of cell division of one class of endothelial cell is disclosed. This showing, together with the previous assertions of applicant's theory of the scope of the pharmaceutical activity of po-ATP, is insufficient as a written description to support claims 1-15 wherein a vast array of combinations of o-ATP with other generic classes of pharmaceuticals has been asserted by applicant to be active against a large number of generic disease conditions, including the generic terms "cancer" and several different cancers, wherein angiogenesis is well known in the art to be a necessary condition to support the growth of the neoplastic tissue. Applicant's assertions are not deemed to be believable because of the absence of direct test evidence showing that the o-ATP in combination with other effective pharmaceuticals have activity against any disease condition in either an intact living host or in an appropriately selected cell culture. See *Ex parte Balzarini et al.* 21, USPQ 2d 1892, 1894 (BPAI, 1991), a decision in its first part standing for the proposition that claims directed to medicinal treatments of diseases in highly unpredictable art areas (cancer and tumour treatments remain highly unpredictable particularly in the area of neoplasms of the nervous system and the pancreas) are properly rejected under 35 U.S.C. §112, first paragraph as lacking

adequate enablement, in the absence of sufficient test data in support of the efficacy of the alleged treatment. See the MPEP at §2107.03 for additional guidance concerning this policy.

Applicant's arguments filed October 2, 2007 have been fully considered but they are not persuasive.

Applicant argues briefly that the instant claim amendments, by their narrowing of the scope of claimed subject matter, have yielded claims that avoid the above grounds of rejection. Examiner respectfully disagrees. The language of claims **2 and 3** extends the claim scope well beyond enabled subject matter even when **Cory et al.** is factored in. Examiner notes that applicant has provided some experimental test data and suggests that, if any additional data is presently available, submission of a declaration disclosing same would be helpful in permitting a more generous view of the scope of subject matter supported by the instant written description.

In addition examiner wonders how the proposed mechanism found in claim 1 would apply to a leukemia wherein the diseased cells are found to be circulating in the blood or lymph systems or, to be separate from other tissues during leukocyte migration through tissues, and therefore are not part of a fixed tissue mass wherein a blood supply must be provided to permit neoplasm growth. Examiner does not understand how VEGF's effect applies in the case of this type of neoplasm.

Claims **1-15** are rejected under 35 U.S.C. §112, first paragraph, because the specification, while being enabled for the inhibition of cell division of a single cell type by the administration of “[periodate] oxidized adenosine triphosphate,” does not reasonably provide enablement for the treatment of any neoplastic or other disease condition wherein the inhibition of angiogenesis or any other effect caused by administration of -- po-ATP -- . The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims.

The fundamental issue here is whether practicing the full scope of the instant invention is possible without undue experimentation. As provided for in *In re Wands* (858 F.2d 731, 737; 8 USPQ 2d 1400, 1404 (Fed Cir. 1988) the minimum factors to be considered in determination of whether a conclusion of “undue experimentation” is appropriate are as follows:

A. The breadth of the claims: The instant claims are directed to the treatment of a vast array of generically defined disease conditions wherein VEGF-induced angiogenesis is effectively inhibited by administration of an effective amount of periodate oxidized ATP (po-ATP), and to pharmaceutical compositions wherein po-ATP is present in combination with a vast array of other medicinally active substances.

B. The nature of the invention: The invention is directed to treating diseases wherein angiogenesis is a necessary part of disease progression and therefore, according to the theory of the disclosure, the inhibition of angiogenesis by administration of po-ATP would be effective in treating the disease.

C. The state of the prior art: Following a review of the art of record it is clear that -- po-ATP -- (defined as the dialdehyde produced by periodate oxidation of ATP) is capable of interfering with certain purinergic receptors, but there is no disclosure in said prior art of the administration of po-ATP alone or in combination with other medicinally active substances to treat atherosclerosis, leukemia, or any other neoplastic disease condition except for lymphoma (Ehrlich's tumor cells) wherein angiogenesis is an essential part of disease development and/or disease progression over time.

D. The level of one of ordinary skill: The ordinary practitioner in the instant art area would be expected to have experience in medical practice and an understanding of biological sciences.

E. The level of predictability in the art: Predictability is inversely proportional to the knowledge of the ordinary practitioner concerning the treatment of the entire spectrum of the disease conditions claimed herein to be effectively treated. Neither the instant disclosure nor the prior art except for one newly cited reference (**Cory et al.**) provide any guidance concerning how to practice the instant claimed method of treatment, thereby rendering the instant art area highly unpredictable.

F. The amount of direction provided by the applicant: The instant disclosure provides only two examples wherein the effect of po-ATP is disclosed as being effective in the inhibition of the cell growth of only one a cell line: human umbilical venous endothelial cells (HUVEC). No additional data is presently of record to support the extrapolation of this data to

the instant claimed subject matter wherein o-ATP is administered in combination with a vast array of different classes of medicinally active ingredients to treat a vast array of disease conditions including all possible diseases classified as a “cancer” listed in claim 3 and one of the neoplastic diseases (leukemia) listed in claim 4.

G. The existence of working examples: Only two working examples have been provided as described in the preceding paragraph.

H. The quantity of experimentation needed to make or use the invention based on the content of the disclosure is deemed to be excessive because of the absence of sufficient test data and associated guidance. The absence of sufficient test data means that the ordinary practitioner does not have the guidance necessary to practice the vast array of different disease treatments without undue experimentation.

Applicant’s arguments filed October 2, 2007 have been fully considered but they are not persuasive.

Applicant argues briefly that the instant claim amendments, by their narrowing of the scope of claimed subject matter, have yielded claims that avoid the above grounds of rejection. Examiner respectfully disagrees. The language of claims **2 and 3** extends the claim scope well beyond enabled subject matter even when **Cory et al.** is factored in.

Claims **1, 5-9 and 15** are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim **1** at line 2, the term “VEGF” is not preceded by a definition of the acronym; e.g. -- vascular endothelium growth factor (VEGF) --? Appropriate amendment in all independent claims (**1, 9 and 15**) is respectfully requested.

Applicant’s arguments with respect to claims **1-6** have been considered but are moot in view of the new grounds of rejection. This new ground of rejection was necessitated by applicant’s amendments.

In claim 1 the term “o-ATP” renders the instant claim incomplete because the meaning of the abbreviation has not been provided in the claim. Examiner suggests that the term should be amended to read -- oxidized ATP (o-ATP) --. In view of the chemical formula of “o-ATP” found at page 11, column 1 of the **Granstein et al. '612** reference (PTO-1449 ref. 1), examiner also notes that the name “oxidized ATP” is misleading because **Granstein's** o-ATP has been both oxidized and reduced, suggesting that the complete chemical structure should also be displayed as part of claim 1 to insure that the intended meaning of the active ingredient in the claimed method of treatment has been accurately represented. Amendment of the disclosure in a similar fashion is also suggested and would not be found to be new matter. Examiner also notes that “o-ATP” is defined as the 2',3'-dialdehyde produced by periodate oxidation of ATP by applicant in the **Ferrero '737** reference (PTO-1449 ref. 5), an indication that the abbreviation “o-ATP” does not have an agreed upon meaning in the art. See also claims **5, 6, 9 and 15**.

Applicant's arguments filed October 2, 2007 have been fully considered but they are not persuasive.

In view of the presence of a very similar acronym in unrelated art (see search in the e-dan file under “Supplemental Content” and the acronym “oatp” meaning “organic anion transport protein”), examiner respectfully suggests that the above noted term, and the above suggestion, should be modified at all occurrences to read -- periodate oxidized ATP (po-ATP) -- in order to avoid any confusion concerning the intended meaning. See also claims **5, 6, 9 and 15** wherein the same newly suggested amendment is appropriate. Examiner will also permit amendment of the disclosure to be consistent with the amended claims as the above suggested change does not represent the introduction of new matter.

In claim **5** the Markush group appearing at lines 3-6 is entirely generic and therefore incomplete because the generic terms presented as Markush group members have not been further defined as specific substances and therefore the claims are both unsearchable and lacking in well defined metes and bounds. A similar problem occurs in re the Markush group at the end of claim **6**.

Applicant's arguments with respect to claims **5-6** have been considered but are moot in view of the new grounds of rejection. This new ground of rejection was necessitated by applicant's amendments.

Claims **5-8** include the term "preparations" but in reality are claims directed to "pharmaceutical composition[s]." The standard format for this type of claim is as follows: -- A pharmaceutical composition comprising {active ingredient(s)} in combination with a pharmaceutically acceptable carrier.-- Claims **5 and 6** are incomplete because they have not specified a -- pharmaceutically acceptable carrier -- and claims **7 and 8** are lacking proper antecedent basis because the -- pharmaceutically acceptable carrier -- necessary to make the particular forms of pharmaceutical compositions specified therein are not provided for, even generically, in the independent claims.

Applicant's arguments with respect to claims **5-6** have been considered but are moot in view of the new grounds of rejection. This new ground of rejection was necessitated by applicant's amendments and new claims **7-8**. Examiner notes applicant's comments in support of amendments to claims **5 and 6** but in view of the above rejection considers same to be beside the point.

Claim **15** is rejected under 35 U.S.C. §112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Claim **15** presently depends from itself.

Applicant's arguments with respect to claims **1-6** have been considered but are moot in view of the new grounds of rejection. This new ground of rejection was necessitated by applicant's amendment.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent."

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States."

(e) the invention was described in

(1) an application for patent described under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application filed under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a)."

(f) he did not himself invent the subject matter sought to be patented."

Claims 1-4 and 9-15 are rejected under 35 U.S.C. §102(b) as being anticipated by Cory et al. (PTO-892 ref. R).

The **Cory et al.** reference discloses the effective inhibition of a neoplastic disease condition (Ehrlich tumor cells aka "lymphoma") in the abstract and at page 818, column 1, Table 1, last two entries. According to one source ("Ehrlich tumor cells" search on the WEB via Google) are a variety of "lymphoma." Therefore, the instant claimed subject matter is deemed to have been anticipated.

Applicant's arguments with respect to claims 1-6 have been considered but are moot in view of the new grounds of rejection. This new ground of rejection was necessitated by the discovery of newly cited prior art.

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

Claims 1-4 and 9-15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Cory et al. (PTO-892 ref. R).

The instant claims are directed to the administration of -- po-ATP -- for the treatment of diseases wherein "VEGF-induced cell division" occurs and has permitted the development of a blood supply and the vessels necessary for same, and also for treatment of the associated neoplasm or other disease. .

The **Cory et al.** reference discloses the effective inhibition of a neoplastic disease condition (Ehrlich tumor cells; e.g. a variety of lymphoma) in the abstract and at page 818, column 1, Table 1, last two entries.

Cory et al. does not expressly disclose the treatment of any other neoplastic disease condition.

The disclosure of the effective treatment of a disease specified at least generically by the instant claims, by a compound well known in the prior art, implies that the mechanism of this treatment, while not specifically disclosed in the prior art, was the effect responsible for the prior art report. Therefore, the instant cited prior art renders obvious from some to all of the claimed treatments of neoplasms and other diseases wherein po-ATP is the active ingredient.

Therefore, the instant claimed methods of treatment of disease conditions wherein VEGF induces tissue blood supply availability, typically in the development of neoplastic tissue growth, would have been obvious to one of ordinary skill in the art having the above cited reference before him at the time the invention was made.

Applicant's arguments with respect to claims 1-6 have been considered but are moot in view of the new grounds of rejection. This new ground of rejection was necessitated by the discovery of newly cited prior art.

Papers related to this application may be submitted to Group 1600 via facsimile transmission (FAX). The transmission of such papers must conform with the notice published in the Official Gazette (1096 OG 30, November 15, 1989). The telephone number to FAX (unofficially) directly to Examiner's computer is 571-273-0651. The telephone number for sending an Official FAX to the PTO is 571-273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner L. E. Crane whose telephone number is **571-272-**

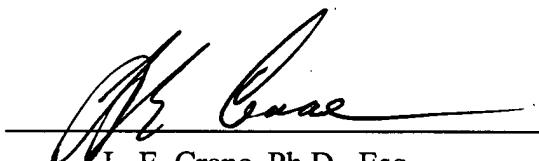
0651. The examiner can normally be reached between 9:30 AM and 5:00 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. S. Anna Jiang, can be reached at **571-272-0627**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is **571-272-1600**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status Information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see < <http://pair-direct.uspto.gov> >. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).

LECrane:lec
12/14/2007



L. E. Crane, Ph.D., Esq.
Primary Patent Examiner
Technology Center 1600